

REMARKS

The application was filed on 14 November 2003 with twenty claims. The Examiner examined the application and on 05 September 2006 issued a first Action. In the Examiner's Action, the Examiner rejected claim 1 under 35 U.S.C. §101, claims 1-5 and 12-20 under 35 U.S.C. §102(3) as being unpatentable over U.S. Patent Application Publication No. 2004/0111690 A1 entitled METHOD FOR COMPOSING MEMORY ON PROGRAMMABLE PLATFORM DEVICES TO MEET VARIED MEMORY REQUIREMENTS WITH A FIXED SET OF RESOURCES to Reuland (Reuland '690). The Examiner also rejected claims 6-11 under 35 U.S.C. §103(a) as being unpatentable over Reuland '690 in view of U.S. Patent Application Publication No. 2001/0010073 entitled NON-STALLING CIRCULAR COUNTERFLOW PIPELINE PROCESSOR WITH REORDER BUFFER to Janik et al. (Janik '073). In response, Applicants amend claim 1. In doing so, Applicants have not added new matter into the application; support in the originally filed specification for "including the largest common memory into the slice definition" is given on page 8 ¶ [0012], lines 8-11 which states: "[t]he method further contemplates embedding the largest common memory into ... the slice"; on page 18 ¶ [0036], line 22 which states: "the optimal creation and diffusion of a memory superset ... implemented on the slice"; on page 21 ¶ [0039], lines 8-10 stating that the "memory block set is then embedded in the base layers of the silicon device"; page 21 ¶ [0039], lines 16-17 which state "a generic memory superset is embedded in the slice"; page 28, line 4 which states, "the memory superset is created in the floorplan of the slice." Applicants further submit a Declaration under 37 CFR 1.131 to swear behind the Reuland '690 reference without admitting that the Reuland '690 reference either anticipates Applicants' claims or render them obvious. Claims 1-20 are pending.

The Rejection of claim 1 under 35 U.S.C. §101

The Examiner rejected claim 1 under 35 U.S.C. §101 saying the method steps do not product a useful, concrete, and tangible result. Applicants have read and reread 35 U.S.C. §101 and nowhere are the words "concrete" or "tangible" required for statutory subject matter. Attorney for Applicants is also aware of and has read the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* published in the Official Gazette on 22 November 2005. After having responded in recent months to many of these rejections that the claims allegedly failing to produce a "concrete and tangible result", Attorney for Applicants are

weary of the Patent Office creating a new statutory requirement for subject matter where none exist. Respectfully, it is the purview of Congress to rewrite laws, not the Patent Office and its Examiners.

Even so, tangible is defined as “possible to be treated as fact; real or concrete: tangible evidence, or **possible to understand or realize: the tangible benefits of the plan**” from <http://www.thefreedictionary.com/tangible>. (Emphasis added). In claim 1, Applicants claim a “method” to design an integrated semiconductor product that inputs a description of processing functions, determines if there are memory requirements associated with the processing functions, and then determines a largest common memory that can satisfy the memory requirements. Applicants have amended claim 1 to add a step of including the largest common memory into the slice definition. Even before the amendment, Applicants assert that the invention of claim 1 is within statutory subject matter of 35 U.S.C. §101, but now is even more concrete and tangible because the largest common memory becomes part of the design of the integrated semiconductor product. Applicants further surmise that these method steps to create a design of an integrated semiconductor product is every bit as tangible as the resultant circuit diagram of the design. The claimed method and resultant design of an integrated semiconductor product, when the claim is viewed as a whole, is a useful, concrete, and tangible result - the result being having enough common memory to satisfy a variety of processing functions that could be configured from the slice. To be able to make, use, and sell such a method and a design is surely patentable subject matter under 35 U.S.C. §101.

Respectfully, if the Examiner maintains the rejection of claim 1 under 35 U.S.C. §101, Attorney for Applicants shift the burden onto the Examiner to show how the claimed method is not useful, concrete, and tangible.

The Rejection of Claims 1-5 and 12-20 under 35 U.S.C. §102(e) over Reuland ‘690 and the rejection of claims 6-11 over Reuland ‘690 in view of Janik ‘073

Applicants submit a Declaration under 37 CFR 1.131 establishing the invention of the subject matter of claims 1-5 and 12-20 prior to the effective filing date of Reuland ‘690. Reuland ‘690 is no longer prior art under 35 U.S.C. §102(e). In doing so, Applicants do not necessarily concur with the Examiner’s rejection of claims 1-5 and 12-20, and fully reserve the right to assert that the claimed invention is neither anticipated by nor obvious in view of Reuland ‘690.

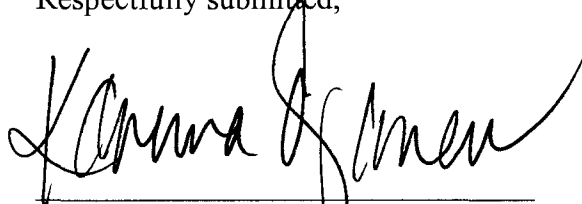
Applicants further overcome the rejection of claims 6-11 over Reuland '690 in view of Janik '073 because Reuland '690 is disqualified as prior art under 35 U.S.C. §103(c). The subject matter of Reuland '690 asserted by the Examiner as prior art under 35 U.S.C. §102(e) shall not preclude patentability under 35 U.S.C. §103(a) because the subject matter of Reuland '690 and the claims 6-11 were, at the time the claimed invention was made, owned by LSI Logic Corporation or subject to an obligation of assignment to LSI Logic Corporation.

Conclusion

The subject matter of claim 1, i.e., the method of the determining the largest common memory to be included in the resultant slice definition is real, understandable, tangible and within the statutory subject matter of 35 U.S.C. §101. With respect to the rejection of the claims 1-20 under 35 U.S.C. §§102(e) and 103, Applicants provide a Declaration under 37 CFR 1.131 establishing invention of the claimed subject matter prior to the effective filing date of Reuland '690 thereby removing Reuland '690 as prior art.

Attorney for Applicants thank the Examiner for her/his review of the application, examination of the claims and consideration of these amendments and remarks. Applicants respectfully request the Examiner to allow the claims and pass the case to issuance. Attorney for Applicants further invite the Examiner to telephone the Attorney listed below if she/he thinks it would expedite issuance of the patent.

Respectfully submitted,



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01 December 2006

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